

REMARKS

In the office action dated November 9, 2007 (Final Office Action), claims 47-48, 50, 51-52, and 54 are rejected under 35 U.S.C. § 102(e) as allegedly anticipated by Carlsson et al. (U.S. Patent No. 7,092,381). The remaining pending claims 49 and 53 are rejected under 35 U.S.C. § 103 over Carlsson in view of a second reference.

Disqualification of Carlsson under 35 U.S.C. § 103(c)

As an initial matter, Applicant notes that the subject matter of Carlsson and the claimed invention of claims 49 and 53 were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person, namely LM Ericsson Telefonaktiebolaget of Sweden, the parent company of Ericsson, Inc., the assignee of the present application. Thus, Carlsson, which qualifies as prior art only under 35 U.S.C. § 102(e), is not available for use in a Section 103 rejection. The rejections of claims 49 and 53 should be withdrawn for at least this reason.

§ 102(e) Rejections over Carlsson

Independent claim 47 of the present invention is directed to an interworking function (IWF) that interconnects a mobile station operating in a conventional TIA/EIA-136 circuit-switched network with a GPRS packet data network. Specifically, claim 47 recites that the claimed interworking function comprises "a teleservice server for transferring packet data to and from a mobile station operating in said TIA/EIA-136 network." Further, the interworking function "enable[es] packet data traffic to be routed between said GPRS network and said mobile station operating in said TIA/EIA-136 network." Thus, the interworking function of claim 47 transfers data packets originating in a GPRS network to a mobile station operating in a TIA/EIA-136 network. Furthermore, the interworking function of claim 47 also transfers data packets

originating at a mobile station in the TIA/EIA-136 network to the GPRS network. The claimed IWF thus allows service providers to provide packet data services in areas where there is insufficient demand to warrant the investment in a packet data infrastructure. Thus, with the claimed invention, a service provider can use its existing circuit-switched wireless infrastructure to deliver packet data.

In contrast, Carlsson discloses a broadcast teleservice message center, residing in a TIA/EIA-136 network, that delivers teleservice messages to mobile stations operating in the TIA/EIA-136 network using conventional means (i.e., via a BATS-based teleservice). (Carlsson, col. 1, lines 25-32.) Carlsson's broadcast teleservice message center also includes an interworking function to re-format broadcast teleservice messages for delivery to mobile stations operating in a GPRS network. (Carlsson, col. 2, lines 56-60). Thus, a single teleservice message center may serve mobile stations operating in TIA/EIA-136 networks and GPRS networks.

Carlsson's disclosure of a broadcast teleservice message center (BMC) does not anticipate claim 47 of the present application. Carlsson's BMC delivers teleservice messages to mobile stations. Carlsson's BMC does not transfer "packet data to and from a mobile station operating in a TIA/EIA-136 network." Furthermore, Carlsson's BMC is incapable of "enabling packet data traffic to be routed between [a] GPRS network and [a] mobile station operating in said TIA/EIA-136 network." Carlsson's BMC resides in a TIA/EIA-136 network. Broadcast messages targeted to phones operating in the TIA/EIA-136 network are sent directly to those phones using system components in the TIA/EIA-136 network. (Carlsson, col. 1, lines 25-49.) Thus, Carlsson does not disclose any interaction at all between a GPRS network and a mobile station in a TIA/EIA-136 network.

In the Final Office Action, the Examiner mistakenly mixes and matches citations from Carlsson to assemble an anticipation argument. For instance, on page 2 of the Final Office Action, the Examiner states:

Carlsson discloses [that] the IWF routes packet data (col. 5, lines 33-35, a mobile station functionally must register with the SGSN 32 to receive packet data service, col. 4, lines 63-65) **to a mobile station** (figure 5, MT) **in a circuit-switched network** (col. 8, lines 5-10, a TIA/EIA-136 network, col. 3, lines 66-67, col. 4, lines 1-2).

Examiner's first citation, to col. 5, lines 33-35, references a discussion of a GPRS-attached mobile terminal operating in a GPRS network. (See Carlsson, Fig.2 and col. 5, lines 33-42.)

Examiner's second citation, to col. 4, lines 63-65, also references a description of packet data service provided to a GPRS mobile terminal, and mentions packet data flowing from a GPRS mobile terminal to an external packet data network (PDN). Examiner's third citation, to col. 8, lines 5-10, references a separate discussion describing delivery of broadcast teleservice messages to a mobile terminal operating in a TIA/EIA-136 network. Importantly, these teleservice messages do not originate in a GPRS network. Furthermore, the cited section says nothing about transferring data from a mobile in a TIA/EIA-136; rather, the discussion is exclusively about one-way messages from a BMC to the TIA/EIA-136 mobile terminal. Finally, Examiner's fourth citation, to col. 3, lines 66-67 and col. 4, lines 1-2, refers once again to a discussion of packet data flowing between a terminal operating in a GPRS network to an external packet data network.

The Examiner's aggregation of unrelated snippets from Carlsson does not support the Examiner's assertion that Carlsson discloses the routing of packet data to a mobile station in a TIA/EIA-136 network. Carlsson does not disclose a "teleservice server for transferring packet data to and from a mobile station operating in [a] TIA/EIA-136 network," as recited in pending claim 47. Rather, Carlsson discloses only the one-way delivery of broadcast messages to mobile terminals in such networks. Further, Carlsson does not "enabl[e] packet data traffic to be

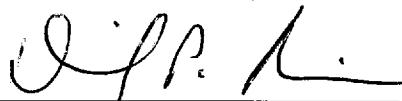
routed between [a] GPRS network and [a] mobile station operating in [a] TIA/EIA-136 network.” Again, with respect to mobile stations operating in a TIA/EIA-136 network, Carlsson discusses only the delivery of broadcast messages originating at a message center resident in the TIA/EIA-136 network.

Claim 51, a method claim roughly corresponding to the apparatus of claim 47, was also rejected in the Final Office Action, for almost identical reasons as claim 47. However, the Examiner’s error in mixing and matching citations is even more apparent in view of this claim. Claim 51 recites that the claimed method includes “receiving mobile originated packets at a teleservice server . . . from a mobile station via a TIA/EIA-136 network.” Carlsson never discusses the origination of packets at a mobile terminal operating in a TIA/EIA-136 network. The sections of Carlsson cited by the Examiner merely discuss the delivery of broadcast teleservice messages to a mobile terminal.

As shown above, independent claims 47 and 51 are improperly rejected, as Carlsson fails to anticipate any of the claims under Section 102. Claims 48-50 and 52-54 depend from claims 47 and 51, and thus are also improperly rejected. Applicant respectfully requests reconsideration of the pending claims in view of the above arguments, and allowance of all pending claims.

Respectfully submitted,

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